

**YAMAP0347USD****Serial No. 09/760,950****REMARKS**

Upon entry of the present amendment, claims 1-7 and 28-39 are pending in the present application. Claims 8-27 have been canceled previously. New claims 28-39 are added herein. Claim 1 is amended, to more particularly point out and distinctly claim Applicants' invention, and claim 4 is canceled. Support for the amendment of claim 1 may be found, for example, in original claim 4 and in the specification, for example, from page 24, line 28 to page 25, line 28. Support for new claims 28-39 may be found in the specification as filed, for example, at page 26, lines 16-20 (claims 28-33) and at page 24, line 28 to page 25, line 4 (claims 34-39).

Upon entry of the present Reply, three independent claims and 18 total claims are pending in the present application. Applicants submit that no additional claim fees are due, since the fee for an equivalent number of claims has already been paid in the present application. See Fee Transmittal filed 15 January 2001.

Applicants respectfully submit that the amended and newly added claims contain no new matter and patentably distinguish over the prior art of record.

**Request for Initialed Copies of Forms PTO-1449**

On January 31, 2003 and February 10, 2003, Applicants submitted supplemental Information Disclosure Statements. Applicants request the Examiner to consider the references cited in these IDSs and to provide Applicants with an initialed copy of the forms PTO-1449 submitted therein. This request was included in both previous Replies to Office Action, but the requested papers were not provided with either Office Action since the request and subsequent reminder were submitted.

Applicants respectfully request the Examiner to provide the requested initialed copies of forms PTO-1449 submitted with these IDSs.

**YAMAP0347USD****Serial No. 09/760,950****Rejection of Claims 1-7 over Tashiro et al. in view of Hirohashi.**

Claims 1-7 stand rejected as obvious over Tashiro et al., U.S. Patent No. 5,515,022, in view of Hirohashi, JP 6-112047, and Mizoguchi et al., U.S. Patent No. 6,593,841.

Applicants respectfully traverse the rejection of Applicants' claims.

The Examiner has admitted that Tashiro et al. and Hirohashi do not disclose the feature that the insulating layers contact each other in the area not in contact with the conductor. However, the Examiner asserts that this feature is found in Mizoguchi et al. and contends that it would have been obvious to combine this feature of Mizoguchi et al. with the previously asserted combination of Tashiro et al. and Hirohashi. Applicants disagree with and traverse this position.

However, Mizoguchi et al. does not include the feature that the magnetic layers are in contact with each other. Rather, the magnetic layers of Mizoguchi et al. are separated from the coils by an insulating layer composed of SiO<sub>2</sub> or polyaniline (see col. 31, lines 1-48 and Fig. 6 of Mizoguchi et al.).

Therefore, Applicants submit that Mizoguchi et al. does not teach or suggest the feature of the present invention wherein the magnetic layers are in contact with each other in the area not in contact with the conductor. This feature is not present in any of the prior art of record. Therefore, Applicants submit that the invention described in claims 1-7 fully patentably distinguishes over the prior art of record and is considered allowable.

Notice to such effect is respectfully requested.

**New Claims 28-33**

New claims 28-33 describe embodiments of the present invention produced by the process of interposing a conductive pattern between two magnetic layers with the features (1) where at least one of the two magnetic layer is in contact with the conductive pattern and (b) wherein the interposing step includes electroforming at least one conductive pattern, and the conductive pattern has a thickness of 10  $\mu$ m or more and a width to thickness ratio of from 1 to less than 5.

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The disclosure of Mizoguchi et al. is limited solely to a conductor separated from both magnetic sheets by an insulator layer. See Mizoguchi et al. Figs. 5, 7 and 24).

Therefore, Mizoguchi et al. fails to teach or suggest feature (a).

As previously noted, Tashiro et al. and Hirohashi disclose inductors formed by printing and do not disclose the properties of feature (b).

Furthermore, those skilled in the art would not be motivated to combine Tashiro et al. and Hirohashi with Mizoguchi et al. because the conductive pattern in Tashiro and Hirohashi is formed by printing whereas the conductive pattern in Mizoguchi et al. is formed by a chemical etching process, which requires the additional insulating films of SiO<sub>2</sub> or the like.

Therefore, claims 28-33 fully patentably distinguish over the prior art of record.

#### **New Claims 34-39**

New claims 34-39 describe embodiments of the present invention in which greensheets are produced by a method (i) consisting essentially of sequentially forming a plurality of ceramic chip inductors which are laminated together to form the greensheet wherein (ii) the conductive pattern has a thickness of 10  $\mu$ m or more and a width to thickness ratio of from 1 to less than 5.

Mizoguchi et al. discloses a method of forming the inductor by first forming an insulator on a substrate. Then, a magnetic layer and an insulating film are formed by sputtering. The conductor is then formed by etching, and this step is followed by another sputtering step to form a further insulating layer, a magnetic layer and a protection layer thereon. See column 31, lines 6-48.

Thus, as clearly disclosed therein, Mizoguchi et al. teaches that a substrate is required in order to produce the inductor whereas the claimed invention of the present application does not require a substrate. Thus, Mizoguchi et al. fails to disclose feature (i) of claims 34-39.

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Furthermore, as discussed above, Tashiro et al. and Hirohashi disclose inductors formed by printing and do not disclose the properties of feature (ii), and those skilled in the art would not be motivated to combine Tashiro et al. and Hirohashi with Mizoguchi et al.

Therefore, claims 34-39 fully patentably distinguish over the prior art of record.

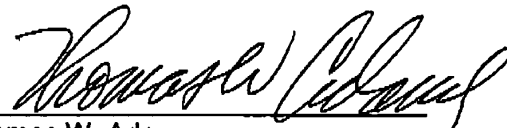
### **Conclusion**

For the foregoing reasons, Applicants respectfully request entry of the present Reply, reconsideration and withdrawal of the rejections of Applicants' claims, and allowance of the application. Applicants respectfully submit that the presently disclosed and claimed invention fully distinguishes over the prior art of record for the reasons set forth herein and previously.

In the event issues arise as a result of the filing of this paper, or remain in the prosecution of this application, Applicants request that the Examiner telephone the undersigned attorney to expedite allowance of the application. No additional fees are believed due for the filing of this paper. Should a Petition for Extension of Time be necessary for the present Reply to the outstanding Office action to be timely filed, petition therefor is hereby made and, if any additional fees are required, the Commissioner is authorized to charge those fees to Deposit Account #18-0988, Docket No. YAMAP0347USD.

Respectfully submitted,  
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